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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,054	01/31/2001	B. Michael Eckard	60990043-1	6040

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EXAMINER
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NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2863

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/773,054

Applicant(s)

ECKARD ET AL.

Examiner

Michael P Nghiem

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-9, 12, 14-16, 19-22, 25, 27 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8, 14-16, 19, 20, 22, 27, 30-33, 45 and 46 is/are allowed.
- 6) ☒ Claim(s) 9, 12, 21, 25 and 34-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

The Amendment filed on June 14, 2004 has been acknowledged.

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 14, 2004 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9, 21, and 34-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia et al. (US 6,042,216).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 9, 21, 34, 36, 40, and 41, Garcia et al. discloses a method and system (via 230, Fig. 14's) for servicing an inkjet printer (Figs. 1, 16) including an inkjet printhead (106) with a nozzle plate (Fig. 4) and a first service module (wiper 234 or capper 236) removably installed on the printer (Fig. 23), comprising:

- identifying a printhead-related service condition (Abstract, lines 3-6) not adequately addressed by servicing the printer with the first service module being in an un-worn condition (complete servicing includes other service module such as a capper, a spittoon, and primer connection, Abstract, lines 6-8);

- providing a second service module (capper 236 or wiper 234) with a service function different from the first service module (Fig. 14a) and adapted to address said printhead-related service condition, the second service module removably installable on the printer and with respect to the first service module (Fig. 23);

- providing the second service module to the printer user (234, 236 is available for use, Fig. 23), wherein the step of providing a set of instructions includes providing a set of human-readable instructions for using the second service module (column 6, line 61 - column 7, line 7, column 8 line 7-18 provide human-readable instructions on how to use the second service module 234, 236).

Regarding claim 35, Garcia et al. discloses providing the second service module to the printer user (234, 236 are available for use, Fig. 23).

Regarding claim 37, Garcia et al. discloses removing the first service module from the printer (by removing service module, column 8, lines 65-67), installing the second service module in the printer (by replacing with new service module, column 8, line 67), and using the set of instructions and the second service module, conducting a special servicing operation (column 8, lines 63-64).

Regarding claims 38 and 42, Garcia et al. discloses that said printhead-related service condition comprises fibers (dust or particle fibers) accumulating on the printhead nozzle plate (Abstract, lines 3-6, and wherein the second service module includes a brush (wiper 234) to remove the fibers.

Regarding claims 39 and 43, Garcia et al. discloses that said printhead-related service

condition includes ink accumulation on the nozzle plate (Abstract, lines 3-6), and wherein the second service module includes a wiper (wiper 234) or applicator having applied thereto a cleaning fluid for removing the ink accumulation (Abstract, lines 3-7).

Regarding claim 44, Garcia et al. discloses that said printhead-related service condition includes global depriming of the printhead or ink starvation of the printhead (well-known problem due to unclean printhead), and wherein the second service module includes a negative pressure primer (240).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. in view of Wojcik (US 6,250,736).

Garcia et al. does not disclose that the second service module includes a wiper fabricated of silicon, or a textile, or a special rubber for removing the ink accumulation.

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Nevertheless, Wojcik discloses a wiper (26) fabricated of silicon or rubber for removing the ink accumulation (column 3, lines 5-11) for the purpose of providing a compliant and durable wiper.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Garcia et al. with a silicon or rubber wiper as disclosed by Wojcik for the purpose of providing a compliant and durable wiper.

***Allowable Subject Matter***

4. Claims 5-8, 14-16, 19, 20, 22, 27, 30-33, 45, and 46 are allowed.

***Reasons For Allowance***

5. The method or combination as claimed wherein removing the first service module from the printer and installing the second service module in the printer in place of the first service module (claim 5, 22, 30, 31, 45) or providing a set of machine readable printer instruction code (claims 7, 19) or said printhead-related service condition includes ink on a printhead carriage interconnect, and the second service module includes a brush arranged to clean the interconnect (claims 14, 27) or the second service module includes a special capping structure having a range of

movement along an axis generally transverse to a nozzle array of the printhead (claims 15, 32) is not disclosed, suggested, or made obvious by the prior art of record.

### ***Response to Arguments***

6. Applicant's arguments filed on June 14, 2004 have been fully considered but they are not persuasive.

With respect to the 35 USC 102 rejections, Applicants argues that there is no teaching that a wiper (234) is removably installable with respect to a capper (236).

Examiner's position is that Fig. 23 of Garcia shows that wiper (234) and capper (236) are two separate parts being assembled into module (230). Wiper (234) fits into holes of (378) (see Fig. 14a) while capper (236) is screwed into plate (380). Fig. 14a shows the screw and Fig. 23 shows the screw holes. Thus, one of ordinary skill in the art would conclude that the wiper (234) and capper (236) are capable of being removable from the module (230).

Applicants further argue that there is no showing in Garcia that the alleged instructions are provided to the printer use, i.e., the Garcia document is provided to the printer user.

Examiner's position is that the disclosure of an invention in a US Patent (including Garcia) is intended for one of ordinary skill in the art to make use of the invention.



Under 35 USC 112, first paragraph, the "specification shall contain a written description of the invention, and of the manner and process of making and **using it**, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and **use the same** and shall set forth the best mode contemplated by the inventor of carrying out his invention".

One of ordinary skill in the art would conclude that a person who uses the invention of a printhead service module (230) is also a printer user because the service module is part of an inkjet printing system (Abstract, lines 1-2).

Applicants further argue that there is no description of how the user can or should use a "module" (234) or (236).

Examiner's position is that part of how to use the wiper (234) or capper (236) is how to install/remove them. Fig. 23 shows how to install/remove the wiper (234) and capper (236). Wiper (234) fits into holes of (378) (see Fig. 14a) while capper (236) is screwed into plate (380). Fig. 14a shows the screw and Fig. 23 shows the screw holes.

With respect to the 35 USC 103 rejections of claims 12 and 25, Applicants argue that Garcia does not address the problem of a printhead-related service condition not adequately addressed by servicing the first module being in an un-worn condition.

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Examiner's position is that the service of one module (e.g. 234) is inadequate for reliable operation of a printhead. A complete service requires the services of all the modules (234, 236, 238) (column 8, lines 61-65).

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (571) 272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**MICHAEL NGHIEM**  
**PRIMARY EXAMINER**

Michael Nghiem

June 28, 2004